

REMARKS

Upon entry of the present amendment, claims 8, 10-12, 16-19, and 21-26 will remain pending in this application. Claims 1-7, 9, 13-15, and 20 were previously cancelled.

Applicant respectfully submits that no new matter is added by the present amendment. In particular, Applicant respectfully submits that the subject matter added to claims 8, 19, and 23 is supported in the Specification at least at page 31, lines 3-10 and 23-32 and in the Drawings at least at Fig. 9 (steps 905-1 through 905-5). The additional subject matter added to claim 19 is supported in the Specification at least at page 32, lines 1-19, and in the Drawings at least at Fig. 9 (steps 905-7 through 905-11). The subject matter added to claim 12 is supported in the Specification at least at page 28, lines 6-10 (bind ID) and page 29, lines 4-15.

Claims 8, 10, 12, 16-17, 19, 21, and 23-25 are understood to stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over U.S. Patent No. 6,856,686 (“DiSanto et al.”) in view of U.S. Patent Application Publication No. 2002/0002674 (“Grimes et al.”).

Claims 11, 18, 22, and 26 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over DiSanto et al. in view of Grimes et al. and further in view of U.S. Patent No. 5,903,723 (“Beck et al.”).

Interview Summary

Applicant’s undersigned representative, Mr. Eiferman, and Examiner Ramy M. Osman participated in a telephonic interview on May 18, 2009, to discuss proposed claim amendments in view of the cited art. Examiner Osman agreed to reevaluate the rejections in view of the amendments and remarks herein.

Double Patenting

Claims 1, 5-8, 10-12, 16-19, and 21-26 are understood to stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-30 of copending U.S. Patent Application No. 10/607,627. Claims 1 and 5-7 were previously cancelled. As to claims 8, 10-12, 16-19, and 21-26, Applicant respectfully traverses the rejection. Claims 8, 12, 19, and 23 have been amended to recite limitations that

render them patentably distinct from claims 1-30 of copending U.S. Patent Application No. 10/607,627. Accordingly, Applicant requests that the rejection of claims 8, 10-12, 16-19, and 21-26 on the ground of nonstatutory obviousness-type double patenting be reconsidered and withdrawn.

Claim Rejections Under 35 U.S.C. § 103(a)

Claims 8, 10, 12, 16-17, 19, 21, and 23-25 are understood to stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over DiSanto et al. in view of Grimes et al. As per claims 8, 12, 19, and 23, the rejection is understood to be based in part on the premise that Grimes et al. discloses digital rights management of restricted content, where the “attachment” is regarded as the restricted content. It is further alleged that Grimes discloses forwarding the retrieved rights data to a rights management server, such rights management server for determining that the recipient is an entity listed in the rights data and issuing to the recipient a license corresponding to the protected content to the recipient based on the rights data, such license specifying rights the recipient has with respect to the protected content as determined from the rights data and also including the decrypted decryption key from the rights data; reviewing the issued license to determine that the recipient has a right to render the protected content of the attachment portion of the email; retrieving the decryption key from the license; and rendering the content. Grimes et al. is alleged to disclose these limitations at least at claims 1-3 and paragraphs 50-56. DiSanto et al. is stated as failing to explicitly disclose these limitations. While it is acknowledged that DiSanto et al. fails to disclose a description of rights, Grimes et al. is alleged to disclose associated “business rules” at paragraphs 41 and 57.

Applicant respectfully traverses the rejection. Claim 8 has been amended to recite the further limitations “using the email application to place the email in a queue when the email is received while the recipient is connected to a network” and “while the recipient is connected to the network, using a trusted component to retrieve the email from the queue and to forward the retrieved rights data to a rights management server.” Claim 19 has been amended to recite similar limitations. Similarly, claim 23 has been amended to recite the further limitation “a recipient computer executing an email application and a trusted component, the email application configured to receive the email, to recognize that the email

has the protected content in the attachment portion thereof, and to place the email in a queue when the email is received while the recipient computer is connected to a network, the trusted component configured to retrieve the email from the queue while the recipient computer is connected to the network and request a license for the protected content.”

These limitations are supported in the Specification at least at page 31, lines 3-10 and 23-32 and in the Drawings at least at Fig. 9 (steps 905-1 through 905-5). As noted at page 30, line 26, to page 31, line 2, “the RM server 54 is likely only available to the recipient of the email 44 by way of a network or the like, and it can be the case that the recipient is not always connectively coupled to such RM server 54 by way of such network. That is, it may be the case that the recipient is connectively coupled to the network to receive the email 44, and does not at such time obtain a corresponding license 36 for the protected content in the email 44.” Accordingly, the invention as recited in claims 8, 19, and 23 offers the advantage of queueing emails for retrieving licenses for RM protected content while the recipient is still connected to the network. Without this feature, the recipient may attempt to render the protected content while the recipient is not connected to the network and is thus unable to obtain a license, and thus may be unable to render the content, even if the recipient is authorized to render the content.

By contrast, it is not seen where Grimes et al. discloses this limitation. Applicant’s review of Grimes et al. suggests that Grimes et al. contemplates that a web browser 56 is used to display content. See, for example, paragraph [0029]. Thus, it is Applicant’s understanding that, in Grimes et al., the content is viewed while the user is online. Accordingly, there would be no motivation to queue emails for retrieving licenses for RM protected content attached to the emails, as recited in claims 8, 19, and 23.

Further, claim 19 has been amended to recite the additional limitations “maintain a list of non-responding rights management servers;” “while the recipient is connected to the network, use a trusted component to retrieve the email from the queue and to forward the retrieved rights data to a rights management server that is not in the list of non-responding rights management servers;” and “if the rights management server does not respond to the forwarded retrieved rights data by issuing the license, then enter the rights management server into the list of non-responding rights management servers.” These limitations are supported in the Specification at least at page 32, lines 1-19, and in the Drawings at least at

Fig. 9 (steps 905-7 through 905-11) and further distinguish various aspects of the claimed invention from the cited art.

Based on at least the above reasoning, Applicant submits that DiSanto et al. and Grimes et al., whether considered individually or in combination with one another, fail to disclose all of the limitations of claims 8, 19, and 23. Accordingly, claims 8, 19, and 23 are patentable over DiSanto et al. in view of Grimes et al. Claim 10 depends from claim 8, claim 21 depends from claim 19, and claims 24-25 depend from claim 23. These dependent claims are also patentable over DiSanto et al. in view of Grimes et al. at least by reason of their dependency.

Claim 12 has been amended to recite the further limitation “wherein the protected content in the attachment portion is encrypted according to a cryptographic key and an item identifier associated with the protected content before the email is encrypted” (underlining indicates added language). It is not seen where Grimes et al. discloses this limitation. First, it is not seen where Grimes et al. discloses encrypting the protected content in the attachment portion before the email is encrypted, that is, separately from the email itself. As disclosed at page 26, lines 20-25, of the instant Specification, “if an attachment 52 of the email 44, such as for example a word processing document, is not itself RM-protected, the RM protection of the email 44 does not automatically protect the attachment 52 once the email 44 has been rendered by a recipient thereof. Accordingly, and without such RM protection, the attachment 52 may be freely and widely distributed in contravention of the goals and purposes of RM.” Further, it is not seen where Grimes et al. discloses encrypting the attachment portion according to both a cryptographic key and an item identifier associated with the protected content, *e.g.*, a bind ID.

For at least the above reasons, Applicant submits that DiSanto et al. and Grimes et al., whether considered individually or in combination with one another, fail to disclose all of the limitations of claim 12. Accordingly, claim 12 is patentable over DiSanto et al. in view of Grimes et al. Claims 16-17 depend from claim 12 and are also patentable over DiSanto et al. in view of Grimes et al. at least by reason of their dependency.

Claims 11, 18, 22, and 26 stand rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over DiSanto et al. in view of Grimes et al. and further in view of Beck et al. The rejection is understood to be based on the premise that Beck et al. teaches compressing

DOCKET NO.: 304791.1 / MSFT-2152
Application No.: 10/607,898
Office Action Dated: March 24, 2009

PATENT

attachments for the purpose of minimizing storage space for transmitting to a recipient. However, Beck et al. does not disclose, and is not alleged in the instant Office Action to disclose, the other limitations of the independent claims that are also not disclosed in either DiSanto et al. or Grimes et al. Accordingly, Applicant submits that claims 11, 18, 22, and 26 are patentable over DiSanto et al in view of Grimes et al. and further in view of Beck et al. at least by reason of their dependency from claims 8, 12, 19, and 23, respectively.

Based at least on the above remarks, Applicant respectfully submits that the currently pending claims are patentable over the cited art and requests reconsideration and removal of the rejections under 35 U.S.C. § 103(a).

DOCKET NO.: 304791.1 / MSFT-2152
Application No.: 10/607,898
Office Action Dated: March 24, 2009

PATENT

CONCLUSION

In view of the above amendments and remarks, Applicant respectfully submits that the present application is in condition for allowance. Reconsideration of the application is respectfully requested.

Date: September 24, 2009

/Kenneth R. Eiferman/
Kenneth R. Eiferman
Registration No. 51,647

Woodcock Washburn LLP
Cira Centre
2929 Arch Street, 12th Floor
Philadelphia, PA 19104-2891
Telephone: (215) 568-3100
Facsimile: (215) 568-3439